

## REMARKS

Claims 1-7, 10-22 and 25-35 remain in the application for further prosecution. Claims 8, 9, 23 and 24 have been cancelled. Claim 16 has been amended. Claims 32-35 have been added.

The Office Action states that “[c]laims 8-9 and 23-24 . . . would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” The Applicants have rewritten claims 8, 9, 23 and 24, which are presented as new independent claims 32-35.

The Office Action also states that “. . . claims 26-31 are allowed over the prior art of record.” (Office Action, page 4.) These claims remain in the application for allowance.

### **Claim Rejections Over Weiss In View Of Ohno In View Of Walker - 35 U.S.C. § 103(a)**

Claims 1-7, 10-22 and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Weiss (U.S. Patent No. 6,165,071) (“Weiss”) in view of Ohno et al. (U.S. Patent No. 5,609,525) (“Ohno”) and in further view of Walker et al. (U.S. Patent No. 6,364,765) (“Walker”). (Office Action, page 2.)

### **The Proposed Modification Cannot Change The Principle Of Operation**

The Office Action states that “. . . it would have been obvious to one of skill the art at the time the invention was made to modify the Weiss in view of Ohno type system by providing the networking environment as taught by Walker in order to be able to save or store player gaming status in the central storage to facilitate data transmission and not having to provide players with memory cards which they can easily lose.” (Office Action, page 3.) To establish a *prima facie* case of obviousness, however, the proposed modification of the prior art cannot change the principle of operation of the prior art being modified.

The modification proposed by the Office Action first requires modifying Weiss to use a network of gaming machines having a central server as described by Walker. Weiss, however, has specifically been designed to eliminate the need for a gaming machine network. Weiss states that it is the object of his invention to provide ". . . a memory card that stores thereon updates with respect to the progress of the player during the course of the series of plays . . ." (Weiss, column 2, lines 46-48.) Weiss further states that another object of his invention is to provide ". . . a player memory card including memory storage means on the card removably accessible to the processor to upload and download information between the processor and a player memory card reflective of status of an ongoing game." (Weiss, column 3, lines 6-10.)

There are many reasons for using a player memory card to eliminate the need for a gaming machine network having a central server. One of these reasons is the reluctance of players to use player tracking cards that record player information collected by the network on a central server. Weiss cites the fact that "[m]any players . . . are reluctant to participate in what they may view as a form of surveillance and therefore player tracking instrumentalities . . . has been met with only moderate acceptance by players." (Weiss, column 1, lines 52-56.) To overcome player resistance to player tracking cards (and their associated storage of player information on a central server), Weiss has developed a player memory card. All player information is stored on the player memory card, thereby maintaining the anonymity of the player and eliminating the central server and its tracking of a player's gaming activities.

The Office Action suggests replacing Weiss's player memory card with Walker's gaming terminal network. This modification, however, fundamentally changes Weiss's operating principle by eliminating Weiss's player memory card. Instead of storing player game play status

on the player memory card, the modification would require the storage of data on a central server; the very operating principle that Weiss tried to overcome in his invention. Weiss intentionally directed his proposed invention away from the use of a network with a central server for storage. The Applicants maintain that the proposed modification fundamentally changes the principle of operation of the Weiss reference and, consequently, the proposed references cannot be used to render the claims *prima facie* obvious.

#### **Weiss Teaches Away From Ohno In View Of Walker**

Weiss reasons that the use of a central server to store player information (which is the current practice with player tracking cards) is *not* well received by many players who are “. . . reluctant to participate in what they may view as a form of surveillance . . .” (Weiss, column 1, lines 53-54.) Weiss’s solution to the problem of maintaining player anonymity is a player memory card that eliminates the storage of player information on a central server. This, by necessity, teaches away from Walker’s operating principle of utilizing a central server to store game play status. Consequently, Weiss’s operating principle, using a player memory card to store game status, is not only incompatible with but also antithetical to Walker’s operating principle of using a gaming terminal network with a central server to store game status.

#### **The Proposed Modification Cannot Render The Prior Art Unsatisfactory For Its Intended Purpose**

The intended purpose of Weiss can be interpreted through its objectives. One of these objectives is stated as “[a] further object of the present invention is to provide . . . a memory card that stores thereon updates with respect to the progress of the player during the course of the series of plays . . .” (Weiss, column 2, lines 44-48.) The Office Action proposes modifying Weiss to include a gaming network with a central server as described by Walker. This eliminates

Weiss's player memory card; the mechanism that accomplishes the fundamental objectives of Weiss's invention.

The memory card is essential to the operation of Weiss. It allows players to anonymously participate in intermittent game play by storing the status of the game on a player memory card. As Weiss states in the specification, “[m]any players, however, are reluctant to participate in what they may view as a form of surveillance and therefore player tracking instrumentalities in which the player is identified has been met with only moderate acceptance by players.” (Weiss, column 1, lines 52-56.) Consequently, Weiss, realizing that a central system for storing player information is not popular with many players, provides a solution that eliminates the central server and allows player game status to be stored on a player memory card.

To eliminate the player memory card (described by Weiss in both the specification and in all independent claims) would render Weiss unsatisfactory for its intended purpose; providing assurance to players that their gaming activity is anonymous. Because the modification renders the prior art unsatisfactory for its intended purpose, a *prima facie* case of obviousness has not been established.

#### **No Suggestion Or Motivation To Combine Reference Teachings**

With regard to the proposed combination of Weiss in view of Ohno, further in view of Walker, in order for any prior art references to be validly combined for use in a prior art § 103 rejection, the references themselves must suggest that they be combined. The Applicants submit that neither Weiss, Ohno nor Walker provide any suggestion of the advantages to be derived from the combination of their teachings, nor the desirability of making the combination, nor any motivation for their combination. In fact, as stated above, Weiss teaches away from and is

Application No.: 09/891,010  
Reply to Office Action dated June 18, 2003

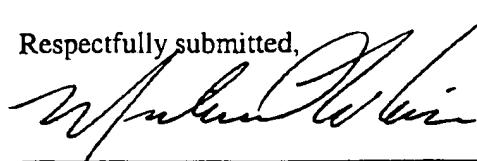
antithetical to Ohno in view of Walker, consequently providing no motivation to combine the references.

**Conclusion**

The Applicants believe that claims 1-7 and 10-35 are in condition for allowance and action towards that end is earnestly solicited. In particular, new claims 32-35 (rewritten dependent claims 8, 9, 23 and 24) are in condition for allowance as indicated by the Office Action if rewritten in independent form. The Office Action also allowed claims 26-31.

If any matters may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants' undersigned attorney at the number shown.

Respectfully submitted,



---

Michael L. White  
Reg. No. 39,421  
(773) 961-1267  
Attorney for Applicants

Date: September 16, 2003